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Docket No. ARYX-117XC1
Serial No. 10/624,713Remarks

Claims 1-11 were pending in the subject application. By this Amendment, claims 1, 3, 4, 6, 7 and 9 have been amended, and claims 2, 5 and 8 have been canceled. The undersigned avers that no new matter is introduced by this amendment. Entry and consideration of the amendments presented herein is respectfully requested. Accordingly, claims 1, 3, 4, 6, 7 and 9-11 are currently before the Examiner for consideration. Favorable consideration of the pending claims is respectfully requested.

In response to the objection to the Declaration set forth in the Office Action, submitted herewith is a corrected Declaration (37 C.F.R. §1.63) and Power of Attorney, executed by Dr. Pascal Druzgala. The serial number listed has been corrected.

The Brief Description of Drawings section has been amended to include descriptions for R, R₁, and X. Support for these descriptions can be found in the Figures themselves as well as, for example, page 8 line 28 to page 9 line 4 of the specification as filed. The Brief Description of Drawings section has also been amended to include reference Figures 2T and 2U. The applicant appreciates the Examiner's careful review of the application.

Claims 1-11 have been rejected under 35 U.S.C. §112, first paragraph. The applicant respectfully submits that the claims as filed were fully enabled by the applicant's specification, and the applicant respectfully traverses this rejection to the extent that it may be applied to the claims now presented. Please note that, in order to expedite prosecution, the claims have been amended herein to lend greater clarity to the claimed subject matter and to focus on the subject matter for which the Examiner has acknowledged an enabling disclosure. Specifically, the claims have been clarified to focus on specific 1, 3-dipropylxanthine molecules substituted at the 8-position. Also, please note that claims 3, 6, and 9 have been amended to be consistent with claims 1, 4, and 7 respectively. Accordingly, the applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. §112, first paragraph.

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Claims 1-11 have been rejected under 35 U.S.C. §112, second paragraph. Please note that, as discussed above, the claims have been amended to lend greater clarity to the claimed subject matter. In this regard, the language with which the Examiner took issue has been removed from claims 1, 4, and 7. Also, the variable X has been removed from claims 3, 6, and 9. Furthermore, claim 7 has been amended to clarify the treatment provided. Support for this amendment can be found throughout the specification including at, for example, page 1 lines 19-27; page 1, line 30 to page 2 line 1; and page 2 lines 25-26.

Claims 1-11 have been rejected under 35 U.S.C. §102(b) as being anticipated by Rzeszotarski (U.S. Patent No. 4,783,530). Also, claims 1, 2, 4, 5, 7, 8, 10 and 11 have been rejected under 35 U.S.C. §102(b) as being anticipated by Kufner-Muhl (U.S. Patent No. 5,696,124). Finally, claims 1-11 have been rejected under 35 U.S.C. §102(b) as being anticipated by Katsushima, 1990 (*J. Med.* Vol. 33, pages 1906-1910). The applicant respectfully traverses these grounds for rejection because the cited references do not disclose or suggest the applicant's advantageous and unique compounds.

It is basic premise of patent law that, in order to anticipate, a single prior art reference must disclose within its four corners, each and every element of the claimed invention. In *Lindemann v. American Hoist and Derrick Co.*, 221 USPQ 481 (Fed. Cir. 1984), the court stated:

Anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim. *Connell v. Sears Roebuck and Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983); *SSIH Equip. S.A. v. USITC*, 718 F.2d 365, 216 USPQ 678 (Fed. Cir. 1983). In deciding the issue of anticipation, the [examiner] must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference. *SSIH, supra*; *Kalman [v. Kimberly-Clarke]*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983)] (emphasis added). 221 USPQ at 485.

In *Dewey & Almy Chem. Co. v. Mimex Co.*, Judge Learned Hand wrote:

No doctrine of the patent law is better established than that a prior patent . . . to be an anticipation must bear within its four corners adequate directions for the practice [of the subsequent invention] . . . if the earlier disclosure offers no more than a starting point . . . if it does not inform the art without more how to practice the new invention, it has not correspondingly enriched the store of common knowledge, and it is not an anticipation. 124 F.2d 986, 990; 52 USPQ 138 (2nd Cir. 1942).

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The cited references do not disclose 1,3 dipropylxanthines with an ester function at the 8-position, wherein the ester function is a cycloalkyl substituted with $-\text{COOR}_1$ and wherein R_1 is alkyl. Accordingly, the applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. §102(b).

In view of the foregoing remarks and amendments to the claims, the applicant believes that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 or 1.17 as required by this paper to Deposit Account 19-0065.

The applicant invites the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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Attachment: Newly executed Declaration and Power of Attorney form

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